REMARKS

In the above-referenced Office Action the Examiner rejected claim 2 because of the inconsistency between "consists of" and "at least about". The claim has now been amended to substitute "comprises" for "consists" and it is requested that the Examiner's rejection be reconsidered and withdrawn.

The Examiner also rejected the Claims under 35 USC 103 citing the patent to Lindh. Reconsideration of this rejection and withdrawal thereof is requested for the following reasons:

1. As pointed out in the instant specification for example at pages 3 and 4 the instant invention is specifically directed at evaluating publicly owned patent portfolios which issued earlier than 2000. Following 1980 publicly owned patents could be licensed and as is also pointed out, when licenses are possible, since they are not recorded, evaluation is very difficult. As pointed out in Claim 1 then Applicant's invention is directed to evaluating only publicly owned patents.

2. In making Applicant's evaluation, it is essential to calculate as described in Claim 1 the ratio of the number of patents to the number of technological classes and the ratio of the number of successive patents referencing an original patent through two generations of referencing patents.

3. The Lindh patent on the other hand is directed to valuing patents or portfolios "for such reasons as determining licensing fees, the value of a company's portfolio,

where much of the research lies and how that relates to the open market" see page 1 paragraph 0002.

4. As pointed out in the instant specification, prior to 1980 publicly owned patents were in the public domain and would not be licensed in any event. Therefore, while Lindh has a very broad disclosure as described therein it is directed to a monetary evaluation.

5. While the Examiner has taken the position that the ratio for purposes of analysis is not disclosed in Lindh but would be obvious is respectively submitted that there is no teaching in Lindh for evaluating publicly owned patents. Since there is no teaching for evaluating publicly owned patents, it would not have been obvious to one skilled in the art to develop the ratios called for in Claim 1. Applicant has discovered however that in the case of publicly owned patents even patents issuing after 1980 and as shown in the drawing herein when heterogeneity and depth increase, the intellectual capital reserve or innovative capital portfolio increases in value. Likewise when those features decrease the opposite result occurs. The instant invention then would have no relevance to Lindh or any other procedure for establishing a portfolio monetary value for example in connection with licensing or the sale of the portfolio. Since there is no teaching in Lindh for evaluating publicly owned patents even though some of the data called for in Lindh is related to some of the data used in the instant invention, there is no teaching for developing the ratios called for in Claim 1 because there would be no purpose to develop these ratios if the purpose was to establish a monetary value, or parameters relating to monetary value.

Accordingly Applicant considers that Claim 1 patentably distinguishes the prior art and Claims 2 and 3 should also be allowable as depending from an allowable independent Claim.

Respectfully submitted,

Donald C. Casey

Donald C. Casey
Registration No. 24,022

311 North Washington Street
Suite 100
Alexandria, VA 22314
(703) 548-2131 DCC:nwl
Date: February 27, 2006

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231

on February 28 2006

N. Wendall